

REMARKS

Formal Matters

Claims 7, 9-14, 16 and 18-20 are pending.

Claims 7-20 were examined and rejected.

Claims 7, 9, 11-14, 16 and 20 are amended. The amendments to the claims were made solely in the interest of expediting prosecution, and are not to be construed as an acquiescence to any rejection of any claim. Support for the amendments to the claims is found in original claim 2, page 6, line 15, element b) of claim 20, and page 7, line 7. Accordingly, no new matter is added.

Claims 8, 15, 17 are canceled without prejudice to renewal, without intent to acquiesce to any rejection, and without intent to surrender any subject matter encompassed by the canceled claims. Applicants expressly reserve the right to pursue any canceled subject matter in one or more continuation and/or divisional applications.

Applicants respectfully request reconsideration of the application in view of the remarks made herein.

Request for Interview

In the event that the Office is not persuaded by the following arguments, the Applicants respectfully request a telephonic interview with the Examiner prior to mailing of an Office Action.

Advisory Action

In the Advisory Action dated January 14, 2004, the Office stated that the Applicants' arguments are again directed to limitations not present in the claims. Specifically, the Office argues that an "electrically-conductive complex", as discussed in the Response to the previous Office Action is not recited in claim 7. Further, the Office argues that claim 16 is void of the limitations discussed in the Response to the previous Office Action.

Without acquiescing to the correctness of this Office Action and solely to expedite prosecution, the Applicants have amended claims 7 and 16 to recite an "electrically-

conductive complex”, and, further, have amended claim 16 to recite “*independently* adding together a probe.... a target...and a metal.”

The Applicants respectfully submit that the pending claims recite limitations not found in the cited art, and, accordingly, the claims are allowable over the cited art. In view of the foregoing, allowance of the pending claims is respectfully requested.

Applicants previous arguments, modified to reflect current claim language, are set forth below.

Rejection under 35 U.S.C. § 103

The Examiner has maintained the rejection of claims 7-20 under 35 U.S.C. § 103 over Blackburn (USPN 6,264,825) in view of Hammershoi (J. Inorg. Biochem, 49:295-304, 1993), because Blackburn assertedly discloses a hybridization method, which, when combined with the transition metal complexes of Hammershoi, renders the claims obvious. The Applicants again traverse the rejection.

The Applicants previously argued that both Hammershoi and Blackburn fail to disclose a method in which a metal ion is used *independently* of the labeled probe, and, as such, these references, taken independently or separately, fail to teach an element of the rejected claims.

In response to our previous arguments, the Examiner stated that “This argument has not been found to be persuasive towards the withdrawal of the rejection, as applicant is arguing limitations not present in the claims. It is noted with particularity that there is no recitation as to when the metal ion is added to the reaction.” In other words, the basis of the response is the Examiner’s assertion that a metal ion, independent of the labeled probe, is not recited in the claims.

In reply to the Examiner’s response, the Applicants respectfully direct the Examiner’s attention to elements (a) and (b) of claim 7, which read as follows:

(a) *hybridizing a probe with an attached transition metal ligand complex to said target nucleic acid to produce an initial complex;*

(b) *adding a metal ion to the initial complex to produce an electrically conductive complex; and,*

(emphasis added)

Similar limitations are found in claim 16 (i.e. "*independently* adding together a probe.... a target...and a metal") and claim 20 (step b of claim 20 recites "adding a metal to the initial complex").

As such, according to the rejected claims, a metal ion *is* added separately to the probe and target. In other words, contrary to the Examiner's response to our previous arguments, the claims recite a metal ion that is *separate* from the labeled probe.

Further, with respect to the Examiner's assertion that there is no recitation as to when the metal ion is added to the reaction, the Applicants note that the wording of claims 7 and 20, as discussed above, indicates that *the metal ion is added to an initial complex of a probe and a target that is already present*. As such, the Applicants respectfully submit that there is a recitation in the claims as to when the metal ion is added to the reaction: it is added *after* the probe.

Accordingly, the Applicants respectfully submit that Hammershoi and Blackburn fail to teach a limitation that *is* present in the claims, namely a metal ion that is independent of the probe.

In view of the foregoing discussion, withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone Tim Joyce at (650) 485 4310.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: Feb 6, 04

By: _____


James S. Keddie, Ph.D.
Registration No. 48,920

Date: 2/6/04

By: _____


Bret Field
Registration No. 37,620